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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/317,303	05/24/1999	BRUCE A. DONOHO	DONO-7	8945
34284 7590 02/26/2007 Rutan & Tucker, LLP 611 ANTON BLVD SUITE 1400 COSTA MESA, CA 92626			EXAMINER PALO, FRANCIS T	
			ART UNIT	PAPER NUMBER
			3644	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/26/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/317,303

Applicant(s)

DONOHO, BRUCE A.

Examiner

Francis T. Palo

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-18 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 and 20-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***RCE***

The Request for Continued Examination (RCE) filed on 11/30/06 under 37 CFR 1.114 is acceptable and an RCE has been established.

An action on the RCE follows.

### ***Response to Amendment/Remarks***

Applicant's arguments filed 11/30/06 have been fully considered but they are not persuasive.

Applicant submits that Richardson's "projections" should be considered part of his base; the examiner respectfully submits that Richardson '269 still reads on, 'a plurality of pairs of prongs extending laterally from opposite sides of the rail' as claimed; applicant's claim language does not serve to patentably distinguish the claimed structure over the laterally extending prongs of Richardson.

Applicant continues to argue the process of forming the instant deterrent as germane to the issue of patentability; while the process limitation has been given consideration it has not been afforded patentable weight in the apparatus claims, as the limitations of forming do not serve to patentably distinguish the claimed structure over that of the Richardson reference.

Applicant submits that Richardson's teaching of "at least four different angles" contemplates other sets of angles (rays) and does not suggest or teach the inclusion of intermediate prongs between the alternating pairs as claimed; the examiner maintains that five-rayed configurations are well-known in the art and that Richardson's teaching encompasses such and that it would have been obvious to one of ordinary skill in the art at the time the instant invention was made, to include a fifth ray in the device of Richardson as claimed.

Further, applicant submits that Burnside '171 and Peles '243 add nothing to the argument; the examiner concurs as these references are relied upon for features recited in the dependent apparatus claims and have not been argued.

Finally, the claim set submitted with the RCE request appears to be the same claim set examined on the merits in the final rejection mailed 8/25/06, and as the arguments filed with this RCE are not convincing, the previous claim rejections are maintained unchanged herein this response to the RCE and this action is made final.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 10-12, 16-18, 20 and 22-34** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over **Richardson** (GB 2344269A) 1998,  
in view of **Shaw** (US 3,282,000) 1963.

Regarding **independent claim-10** and dependent **claim-11**:

Richardson discusses on page-4 and depicts in the figures a bird deterrent for mounting on a surface comprising an elongated ('sinuous') and sectioned (16, 17) rail of plastic (15) wherein, the base of each of the prongs is provided by a projection that extends laterally from the main path of the rail of plastic (15); this lateral teaching is read as 'prongs extending laterally' as claimed and argued above in the **Response to Amendment/Remarks**.

Richardson further depicts alternating pairs of prongs (11,12) and (13,14) in figure-3 which, when compared to applicant's invention as depicted in instant figure-3, comprising alternating pairs of prongs (26,28) and (24,30) are readable on the instant limitation, 'alternating between a higher position and lower position', as claimed;

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specifically, in the Richardson pair of prongs (11,12), prong (12) is higher than prong (11) and in the successive pair (13,14), prong (13) is higher than (14) or (11), just as depicted in figure-3 of the instant invention, wherein (28) is higher than (26) and (24) is higher than (30).

Richardson by contemplating more than four angles to the base element provides the motivation for a fifth angle, such as claimed by applicant's 'upwardly extending intermediate prongs disposed', as claimed and as taught by **Shaw '000**.

As previously submitted and maintained, Shaw '000 teaches a five-rayed plastic construction having an upwardly extending intermediate prongs (figure-1, element-20), as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided Richardson with an intermediate prong (20) as taught by Shaw, as Richardson contemplates more than four angles to the base element.

Regarding **claim-12**:

The discussion above regarding claim-11 is relied upon.

Richardson as modified by Shaw is readable on the instant claim, as Richardson teaches angles less than 90°.

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Regarding **claims 16 and 17**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts a base readable as a rail and side projections extending from the base (rail) continuous with the rail, as claimed.

Regarding **claim-18**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches prongs extending upwards from side projections extending laterally from the main path of the strip-like base element at line-15 (thereabout) on page-3.

Regarding **claims 20 and 22**:

The discussion above regarding claim-10 is relied upon.

Prongs as claimed, are readily apparent from figure-1 of Richardson.

Regarding **claims 23 and 24**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches (depicts) a base (read as a rail) having a flat bottom surface and a trough; the trough located on the upper surface of the base.

Note: it is not clear from the claim language which side the trough is located.

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Regarding **claim-25**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts in figure-1 structure(s) readable on a ridge, as claimed.

Regarding **claim-26**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts a tapered spike readable as having first and second portions having a round cross-section; Richardson as modified by Shaw is readable therefore thereon the instant claim.

Regarding **claim-27**:

The discussion above regarding claim-10 is relied upon.

Richardson as modified by Shaw renders a five-fanned projection as claimed.

Regarding **claim-28**:

The discussion above regarding claim-10 is relied upon.

Richardson as modified by Shaw renders a normal extending prong as claimed.



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Regarding **claim-29**:

The discussion above regarding claim-10 is relied upon.

As discussed above in the rejection of claim-28, Richardson as modified by Shaw renders a normal extending prong as claimed, and while Richardson teaches ridges running along the upper surface of the rail (base), Richardson is silent as to upwardly extending prongs being normal to a ridge running along an upper surface of the rail.

Shaw teaches normal prong extension from a ridge as depicted in figures 4 and 7.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include an upwardly extending intermediate prong as taught by Shaw and as claimed, for the known advantages of that feature.

Regarding **claim-30**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts cutting notches on the underside of the base (rail) as claimed.

Regarding **independent claim-31**:

The discussion above regarding independent claim-10 is relied upon as encompassing the broad instant claim.

Regarding **claims 32-34**:

The discussion above regarding claim-31 is relied upon.

The structure and orientation of the prongs as claimed are readily apparent from the depictions of Richardson.

**Claims 13-15** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over **Richardson** and **Shaw**,  
as applied to claims 10 and 11 above,  
and further in view of **Burnside** (US 2,777,171) 1951.

Regarding **claims 13-15**:

The discussions above regarding claims 10 and 11 are relied upon.

Richardson teaches prong angles on the order of 60 and 82° to the underlying base (page-4, lines 25 and 36) and therefore on the order of 22° difference between the prongs; Richardson does not teach about 30 and 70° and a difference of about 40°, as claimed.

Richardson in column-4 at lines 18 and 24 (thereabout) recites, "in this example the angles"; the language is read as motivation for other angles to be utilized other than discussed and depicted in the teaching.

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Burnside teaches prongs (11-15) "bent upwards at different angles..", (column-3, lines 22-23) and prongs (21-25), "bent at somewhat different angles than those of figure-1", (column-3, lines 28-29).

The Examiner submits that Burnside teaches the angles claimed in the instant claims, or at least the obviousness for that capability, that is; prong angles of about 30 and 70° are apparent from the figures 1 and 2 of Burnside.

It would have been obvious therefore to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, and depicted and inferred by Burnside, for the known advantages of that feature.

**Claim-21** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Richardson** and **Shaw** as applied to claim-10 above, and further in view of **Peles** (US 2,938,243) 1953.

Regarding **claim-21**:

The discussion above regarding claim-10 is relied upon.

Richardson is silent as to prong cross-section configuration except for the depictions, which resemble tapered prongs having circular cross-sections.

Peles '243 teaches a prong readable on a cross-shaped cross-section (at a minimum a partial cross-shaped cross-section) to provide rigidity to the prongs (column-2, lines 20-22).

As it has been held that mere duplication of essential working parts of a device requires only routine skill in the art (*In re Japikse*, 86 USPQ 70), it would have been obvious to reproduce the ridge (21) on the other side of the Peles prong for the known advantage of that feature, which would enable the full cross-shaped cross section as claimed.

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong cross-section as claimed as taught by Peles, for the known advantage of that feature as taught by Peles.

**Claim-35** is rejected under 35 U.S.C. 103(a),  
as being unpatentable over **Richardson** in view of **Burnside**.

Regarding **new independent claim-35**:

Richardson as discussed above in the rejection of claim-10 teaches an integrally molded deterrent as claimed, and teaches prong angles on the order of 60 and 82° to the underlying base (page-4, lines 25 and 36); Richardson does not specifically recite no more than 70°, as claimed.

Burnside as discussed above in the rejection of claims 13-15 provides the teaching for various angles, which would encompass the claimed 70° prong angle.

It would have been obvious therefore to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, and as depicted and inferred by Burnside, for the known advantages of that feature.

**Conclusion**

This is an RCE of applicant's application, which contains claims unchanged over the earlier claim set presented for examination on the merits in the response filed 6/2/06. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Francis T. Palo*

Francis T. Palo  
Primary Examiner  
Art Unit 3644